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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,280	01/30/2002	Terumi Matsuda	2091-0249P	2656

7590 03/11/2005

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,280

Applicant(s)

MATSUDA ET AL.

Examiner

Marissa Thein

Art Unit

3627

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings filed on January 30, 2002 are acceptable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because it fails to recite computer program instructions stored in a computer readable medium. The claim is directed to a program. Giving the terms its broadest reasonable interpretation, the claims are directed to a program per-se. Accordingly, the claim fails to recite a positive functional interrelationship between a medium and the activities recited. Please refer MPEP 2106.

Claim 21 is rejected under 35 U.S.C. 101 because it fails to recite computer executable instructions. The claim is directed to a recording medium. Giving the terms its broadest reasonable interpretation, the claims are directed to a program per-se. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer MPEP 2106.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3627

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because the program product should recite instructions or code for performing the steps rather than the steps themselves.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6-13, 15-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,636,837 to Nardozzi et al in view of U.S. Patent No. 6,321,231 to Jebens et al..

Regarding claims 1, 13, 17 and 20, Nardozzi discloses a print order system and a program comprising: order reception servers (computer 39) enabling reception of order information regarding image data via a network (the computer ...are received communicates with the remote collection database systems so as to obtain an order information ; col. 3, lines 60-63) and installed respectively in a photograph processing agencies (photo finishing lab 39) each having a photographic printer for printing the image (col. 3, lines 53-64; col. 6, lines 19-23; col. 10, lines 45-67); and an order terminal (ordering apparatus; remote kiosks 10) connected to the order reception servers via the

Art Unit: 3627

network (Figure 2), the order terminal generating the order information and placing an order for a print of the image data by transferring the order information to a corresponding one of the order reception servers installed in a photograph processing agencies (indicia identifies the photofinishing lab which the order is to be sent for completion, col. 7, lines 39-40) after directly accessing the order reception server of the photographic processing agency (col. 3, lines 24-34; col. 3, lines 53-64); and a photographic printer for outputting a print of image data (col. 6, lines 19-27).

However, Nardozzi does not explicitly disclose plurality of photographic processing agencies. Nardozzi discloses retail establishment which sends the photofinishing orders to more than one central photofinishing lab (col. 2, lines 18-20). Nardozzi further discloses a photofinishing 38 includes a computer 39 (col. 6, lines 33-34) and an indicia which identifies the photofinishing lab (col. 7, lines 39-41).

Jebens, on the other hand, teaches the plurality of photograph processing agencies (jobber) (col. 22, lines 24-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made modify the system of Nardozzi to include the plurality of photographic processing agencies, as taught by Jebens, in order to provide a selection for the user (Jebens, col. 22, lines 24-28).

Regarding claims 2 and 18, Nardozzi discloses the order information is generated and transferred by a program installed in the order terminal (col. 2, lines 54-61).

Art Unit: 3627

Regarding claims 6-12, 15-16 and 21, Nardozzi discloses wherein the access information used for accessing the order reception server of the agency is printed on a printing medium and the order terminal reads the access information from the printing medium (Figure 4a; col. 7, lines 30-41; col. 7, lines 57-65); wherein the access information is obtained a predetermine Web server and the order terminal access the order reception server (Figure 5b and Figure 5c; col. 5, lines 24-31); wherein information used for accessing the order reception server of the specific agency and obtains photographic processing agency information regarding the specific photograph processing agency (Figures 5a-5g); a charge of the print (col. 5, lines 36-41) and the item of delivery of the print (Figure 4a); notifies the order terminal of status of printing based on the order information (col. 3, lines 50-64); attachment information output means for printing attachment information to be attached to the print (col. 9, lines 18-52); and access information for directly accessing an order reception server installed in a photograph processing agency (col. 10, lines 45-67).

Claims 3-5, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nardozzi and Jebens as applied to claims 1, 13, and 17 above, and further in view of U.S. Patent No. 6,812,962 to Fredlund et al. Nardozzi and Jebens substantially disclose the claimed invention, however, the combination does not disclose the recording medium recorded with access information. The combination does disclose a computer software program for monitoring the sales of the photofinishing goods and/or services (Nardozzi, col. 2, lines 57-59).

Art Unit: 3627

Fredlund, on the other hand, teaches the recording medium recorded with access information (col. 4, lines 50-62; col. 5, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Nardozzi and Jebens, to include the recording medium recorded with access information, as taught by Fredlund, in order for automatically forwarding image data which is simple in construction and easy to use (Fredlund, col. 2, lines 18-20).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,324,521 to Shiota et al. discloses a network photographic service.

U.S. Patent No. 6,388,732 to Williams et al. discloses a method for producing photographic prints.

U.S. Patent No. 6,657,702 to Chui et al. discloses facilitating photographic print re-ordering.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
March 7, 2005


Richard Chilcote
Patent Examiner
Electronic Business Center
3627